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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Akitoshi Kojima

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EXAMINER

ARAQUE JR, GERARDO

ART UNIT

PAPER NUMBER

3689

NOTIFICATION DATE

DELIVERY MODE

06/10/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/995,652	Applicant(s) KOJIMA ET AL.	
	Examiner Gerardo Araque Jr.	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 14** is rejected under 35 U.S.C. 102(b) as being anticipated by **Trotta, Jr. (US Patent 5,595,264)**.

4. In regards to **claim 14**, **Trotta** discloses a portable terminal comprising:
tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and customer identifying information written onto another wireless tag(**Fig. 4 #23**);

storage for accumulating and storing commodity information that has been read by the tag reader (**Fig. 4 #27**);

wireless communication device for transmitting commodity information to an information-processing apparatus via radio waves at the same time that the commodity information is stored in the storage, and transmitting the customer identifying information to the information-processing apparatus via radio waves (**Fig. 4 #40**); and

display for displaying the commodity information that has been read out (**Fig. 4 #22**).

Further still, the Examiner considers customer identifying information to be nonfunctional descriptive subject matter since it does not affect how the apparatus functions, communicates, or stores information. The type of data adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art. As claimed, the steps of the invention would be performed the same regardless of the type of data used. As a result, the Examiner asserts that the portable terminal as disclosed by **Trotta** is fully capable of reading information via radio waves from multiple wireless tags.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1 – 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Trotta, Jr. (US Patent 5,595,264)** in view of **Garver (US Patent 7,114,656 B1)**.

7. In regards to **claims 1 – 3**, **Trotta** discloses a merchandise retail management method comprising the steps of:

putting a tag on display together with a sample commodity in a display area, commodity information including an identification code of the commodity, being allowed to be read from the tag (**Col. 2 Lines 55 – 56**);

lending out a portable terminal capable of reading the tag to a customer entering the display area **(Col. 3 Lines 56 – 57)**;

reading the commodity information from the tag, which is put on display together with the corresponding sample commodity, with the portable terminal when the customer indicates an interest in purchasing the commodity **(Col. 5 Lines 1 – 29)**;

storing the corresponding commodity information in the portable terminal and relaying it to an information-processing apparatus for merchandise management and sales management **(Col. 1 Lines 56 – 59; Col. 4 Lines 30 – 40; Col. 5 Lines 55 – 57)**;

comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus **(Col. 4 Lines 30 – 40; see also at least Col. 6 Lines 2 – 8; wherein the information processing apparatus is the in-store computer that keeps the running total of the customer's purchase [Col. 5 Lines 35 – 42] and receives the information as the customer is scanning the commodity and wherein the scanner terminal acts as the POS apparatus since it is the location where payment is finalized. Further still, a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would identify the scanner with the customer, and when the scanner is placed back at the scanner terminal another type of identifier must then be transmitted from the scanner terminal to the in-store computer in order to compare that the two identifiers are the same in**

order to release the customer's payment card and the printing of the receipt of the total purchases.);

the customer returning the portable terminal when leaving **(Col. 6 Lines 2 – 4);**
and

handing over of the commodity to the customer after the commodity to be sold has been prepared in accordance with the comparison result of commodity information at the information-processing apparatus **(Col. 6 Lines 8 – 12).**

However, **Trotta** fails to teach:

putting a tag on display together with a sample commodity in a display area, commodity information including an identification code of the commodity, being allowed to be **written** to the tag.

Garver teaches a method and system similar to **Trotta** in that a portable terminal is provided to a customer in order to cut total shopping time by reducing the amount of time spent at checkout. **Garver** further discloses that it is also old and well known that various types of indicia, such as RFID tags, can be used to read and write the commodity information on the commodity **(Col. 3 Lines 18 – 20; Col. 5 Line 40)**. As a result, providing an RFID tag would allow for the RFID tag to be used multiple times because of their characteristic of having its data be rewritten and that they do not require an unobstructed line of sight between the tag and the reader **(additional information can be found at**
http://whatis.techtarget.com/definition/0,,sid9_gci1038008.00.html**).**

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teaching of **Garver** to modify **Trotta** to have sample commodity with the corresponding RFID since they can be rewritten with new commodity information in order to reuse the tags and avoid purchasing new tags when replacing old commodities with new commodities or for a price change, as well as the additional benefit that an RFID tag does not require an unobstructed line of sight between the tag and the reader.

8. In regards to **claim 4**, although **the combination of Trotta and Garver** fails to disclose further comprising a rewriting apparatus for rewriting the commodity information on the wireless tag.

However, the Examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention that a rewriting apparatus to be obviously included since an RFID tag requires some type of read/write device so that the information can be stored on the RFID tag (**additional information can be found at http://whatis.techtarget.com/definition/0..sid9_qci1038008.00.html**).

Therefore, it would have been obvious to one having ordinary skill in the art for the **combination of Trotta and Garver** to disclose a rewriting apparatus for rewriting the commodity information on the wireless tag since an RFID tag requires some type of read/write device so that the information can be stored on the RFID tag.

9. In regards to **claims 5 – 6**, **Trotta** discloses wherein the portable terminal includes:

input means with which the customer commands an arithmetic process relating to stored commodity information (**Col. 5 Lines 1 – 29**); and

arithmetic means for conducting arithmetic processing according to the command to the input means (**obviously included**).

10. In regards to **claim 7**, **Trotta** discloses wherein the portable terminal includes:

input means with which the customer designates stored commodity information (**Col. 6 Lines 33 – 35**); and

display means for displaying commodity information in accordance with the designation made to the input means (**Col. 4 Line 21**).

11. In regards to **claim 8**, **Trotta** discloses wherein the portable terminal relays commodity information to at least one of a POS apparatus and an information processing apparatus at the same time that the portable terminal reads out the commodity information from the wireless tag (**Col. 3 Lines 8 – 11; see also at least Col. 4 Lines 30 – 40; see also at least Col. 6 Lines 2 – 8**).

12. In regards to **claim 9**, **Trotta** discloses wherein the information-processing apparatus includes:

wireless communication means for wireless communication with the portable terminal held by a customer checking out (**Col. 3 Lines 8 – 11; Col. 4 Lines 15 – 20**); and

customer specification means for specifying customers by wireless communication via the wireless communication means (**Col. 3 Lines 8 – 11; Col. 4 Lines 38 – 40**).

13. In regards to **claim 10**, **Trotta** discloses wherein the information-processing apparatus further includes:

commodity information readout means for reading out the commodity information stored in the portable terminal through wireless communication with the portable terminal via the wireless communication means (**Col. 4 Lines 38 – 40**);

display means for displaying a list of commodity information that has been read out by the commodity information readout means (**obviously included**);

correction input means for receiving corrected input from customers who have viewed the list displayed by the display means (**Col. 6 Lines 33 – 50**); and

commodity correction means for correcting commodity information in accordance with the corrected input when the corrected input means receives corrected input (**Col. 6 Lines 33 – 50**).

14. In regards to **claim 11**, **Trotta** discloses wherein the information-processing apparatus carries out revision and addition of information to the list through wireless communication with the portable terminal via the wireless communication means (**Col. 5 Lines 48 – 65**).

15. In regards to **claims 12 – 13**, **Trotta** discloses wherein the information-processing apparatus is further provided with payment processing means capable of processing payment for sales, displayed by the display means (**Col. 6 Lines 5 – 12**).

16. **Claims 15 – 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Trotta, Jr. (US Patent 5,595,264)** in view of **Garver (US Patent 7,114,656 B1)** in further view of **Murrah et al. (US Patent 5,804,807)**.

17. In regards to **claims 15 – 16, the combination of Trotta and Garver** discloses that the scanner, which reads information via radio waves, is released from its holder to a customer after an authorized credit card, debit card or like payment is accepted

However, **the combination of Trotta and Garver** fails to explicitly disclose:
wherein the portable terminal reads via radio waves customer identifying information written onto another wireless tag, and transmits the customer identifying information-processing apparatus via radio waves.

Murrah discloses a similar system where any potential user is capable of using a portable terminal for scanning indicia off of products. **Murrah** further discloses an embodiment where a roving attendant uses the portable scanning terminal to create an itemized list of all items in a customers shopping cart. The roving attendant initiates a pre-register transaction by scanning or manually entering the customer's purchase record identifier, which is a store loyalty card, into the terminal. **Murrah** also discloses that the method for scanning indicia can be accomplished using radio frequency identification tags. From this teaching it can be seen that one having ordinary skill in the art would have realized from the teachings of **Murrah** that it was old and well known in the art for portable terminals to not only be capable of scanning information off of products through radio waves, but that customer identifying information can be scanned as well (**see at least Col. 3 Lines 5 - 7; Col. 4 Lines 6 – 23; Col. 7 Lines 63 – 67**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **the combination of Trotta and Garver** to have a portable terminal to further read customer identifying information written onto another wireless tag, via radio waves, as a means of creating a transaction record that would contain the customer identification which would be linked with the scanned commodity information.

Response to Arguments

18. Applicant's arguments filed 2/19/08 have been fully considered but they are not persuasive.

Rejection under 35 USC 112, second paragraph

19. The rejection made under 35 USC 112, second paragraph, has been withdrawn due to the amendments that were filed on 2/19/2008.

Rejection under 35 USC 102

20. In response to applicant's argument that **Trotta** fails to disclose, "...a portable terminal comprising a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remove from a checkout area **and customer identifying information written onto another wireless tag...and transmitting the customer identifying information to the information-processing apparatus via radio waves...**", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The Examiner considers customer identifying information to be nonfunctional descriptive subject matter since it does not affect how the apparatus functions, communicates, or stores information. The type of data adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art. As claimed, the steps of the invention would be performed the same regardless of the type of data used. As a result, the Examiner asserts that the portable terminal as disclosed by **Trotta** is fully capable of reading information via radio waves from multiple wireless tags.

Rejection under 35 USC 103

Claim 1

21. In regards to applicant's argument that **the combination of Trotta and Garver** fails to teach or suggest, "...comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information **which is sent from the portable terminal to a POS apparatus at a sales counter** and is then entered into the information-processing apparatus."

However, as discussed in detail above, the information processing apparatus is the in-store computer that keeps the running total of the customer's purchase [Col. 5 Lines 35 – 42] and receives the information as the customer is scanning the commodity and wherein the scanner terminal acts as the POS apparatus since it is the location where payment is finalized. Further still, a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would

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identify the scanner with the customer, and when the scanner is placed back at the scanner terminal another type of identifier must then be transmitted from the scanner terminal to the in-store computer in order to compare that the two identifiers are the same in order to release the customer's payment card and the printing of the receipt of the total purchases.

As a result, the Examiner asserts that **the combination of Trotta and Garver** does, indeed, teach or suggest, "...comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information **which is sent from the portable terminal to a POS apparatus at a sales counter** and is then entered into the information-processing apparatus."

Claim 3

22. In regards to applicant's argument that **the combination of Trotta and Garver** fails to teach or suggest the POS apparatus communicating with the information processing apparatus in the manner as claimed in claim 3 the Examiner is uncertain as to the specifics of the applicant's argument, i.e. what specific limitation of the communication process does **the combination of Trotta and Garver** fail to teach or suggest. As a result, the Examiner will assume that the communication process that **combination of Trotta and Garver** fails to teach or suggest is the communication process that has already been discussed for claim 1. Specifically, "...comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information **which is**

sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus.”

However, as discussed in detail above, the information processing apparatus is the in-store computer that keeps the running total of the customer's purchase [Col. 5 Lines 35 – 42] and receives the information as the customer is scanning the commodity and wherein the scanner terminal acts as the POS apparatus since it is the location where payment is finalized. Further still, a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would identify the scanner with the customer, and when the scanner is placed back at the scanner terminal another type of identifier must then be transmitted from the scanner terminal to the in-store computer in order to compare that the two identifiers are the same in order to release the customer's payment card and the printing of the receipt of the total purchases.

As a result, the Examiner asserts that **the combination of Trotta and Garver** does, indeed, teach or suggest, "...comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information **which is sent from the portable terminal to a POS apparatus at a sales counter** and is then entered into the information-processing apparatus.”

Dependent Claims

23. All rejections made towards the dependent claims are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed

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errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and unpatentable over **Trotta, Jr.** and, where appropriate, in view of **Garver**.

Claims 15 and 16

24. Regarding newly added claim 15 and 16, the Examiner has addressed those limitations in the provided rejection.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in the PTO-892 Notice of References Cited.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./
Examiner, Art Unit 3689
5/31/08

/Dennis Ruhl/
Primary Examiner, Art Unit 3689